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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,536	08/28/2003	Geoff Finlay	1672-3/AMK	9034
7590	11/03/2004		EXAMINER FITZGERALD, JOHN P	
Adrian M. Kaplan c/o Dimock Stratton LLP 20 Queen Street West Suite 3202, Box 102 Toronto, ON M5H3R3 CANADA			ART UNIT	PAPER NUMBER
			2856	
			DATE MAILED: 11/03/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,536

Applicant(s)

FINLAY ET AL.

Examiner

John P Fitzgerald

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 11-13, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 5, 7-10, 14-17 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/10/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Canada on 27 August 2003. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter. Furthermore, foreign priority papers have not been filed by the applicant.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "pre-fog fluid" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

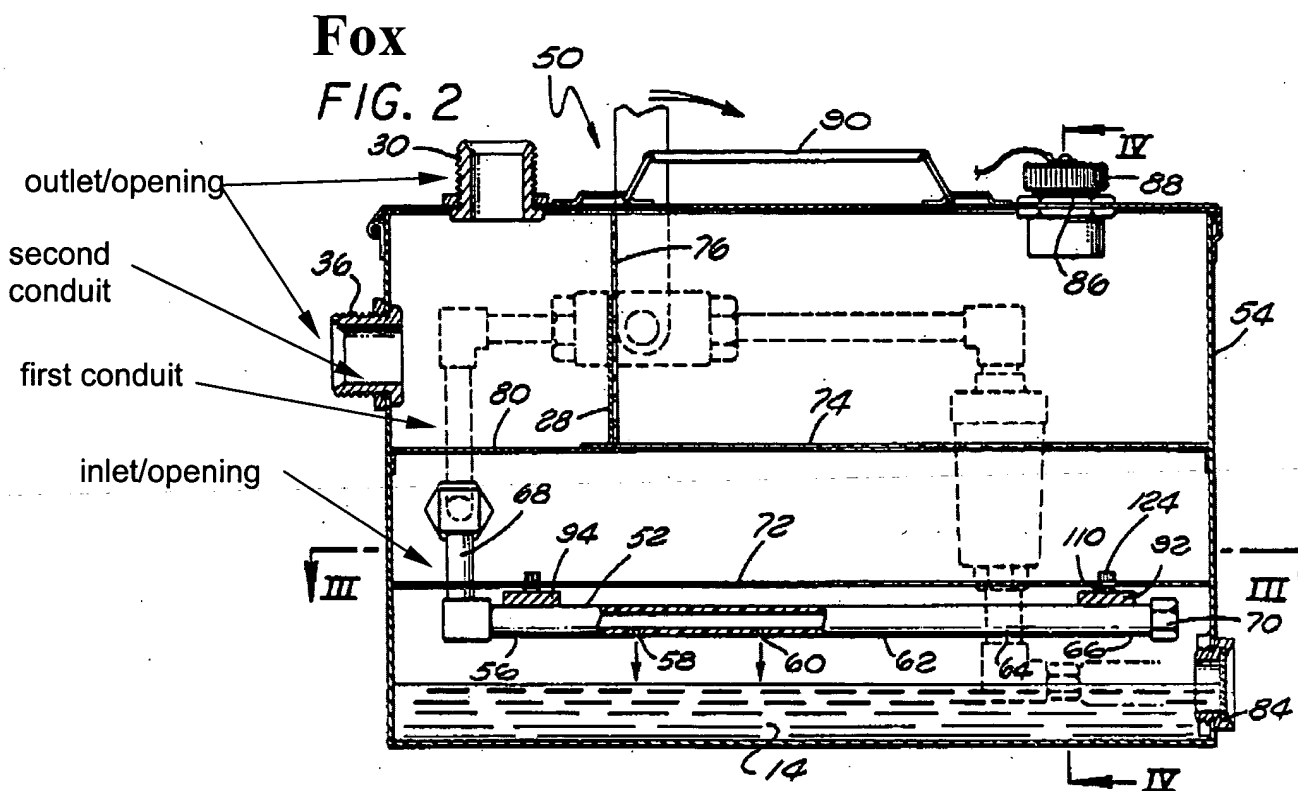
5. Claims 1-4 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by US 4,836,452 to Fox. Fox discloses a leak detector (Figs. 1-8) for connection to an air supply (40) and being adapted to deliver vapor/fog (i.e. fine droplets or mist) (as recited in claim 3) under

Art Unit: 2856

pressure to a system for detecting leaks having: a tank (54) defining a fluid (14) chamber for holding a quantity of mineral oil based fluid (Fox: col. 1, line 13) (as recited in claim 4), the tank further defining a an inlet/first opening (68) (see Fig. 2 below) and an outlet/second opening (30, 36); a first conduit (22) for delivering air from the air supply having a first end for attachment to the air supply and a second end received in the inlet (68); the second end of the conduit (52) being positioned to direct a flow of air from the air supply into the fluid chamber against the fluid thereby generating a vapor/fog; and a second conduit (see Fig. 2 below) for delivering the vapor/fog from the fluid chamber to the system, the second end having a first end received in the outlet and a second end receivable in the system; further comprising a spray nozzle (58, 60) attached to the second end of the first conduit for directing flow of air against the pre-fog fluid (as recited in claim 6). Since the “system” are/is not part of the claims, they are not given any patentable weight. Furthermore, the “adapted to” phrases such as “adapted to deliver vapor under pressure to a system....” is an intended use and/or desired result which carries no patentable weight. Lastly, functional recitation(s) using the words “for” have been given little patentable weight because they fail to add any structural limitations and thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Finstewalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). **When interpreting functional language, if the prior art is capable of performing the claimed**

Art Unit: 2856

function-even if not directly disclosed-it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Sinex*, 309 F.2d 488, 135 USPQ 302 (CCPA 1962). See also MPEP § 2114, 2115.



6. Claims 11-13 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by US 4,836,452 to Fox. Fox discloses a leak detector (Figs. 1-8) for connection to an air supply (40) and being adapted to deliver vapor/fog (i.e. fine droplets or mist) (as recited in claim 12) under pressure to a system for detecting leaks having: a tank/housing (54) defining a fluid (14) chamber for holding a quantity of mineral oil based fluid (Fox: col. 1, line 13) (as recited in claim 13), the tank further defining a an inlet/first opening (68) (see Fig. 2 above) and an

Art Unit: 2856

outlet/second opening (30, 36); a first conduit (22) for delivering air from the air supply to the fluid chamber having a first end for attachment to the air supply and a second end received in the inlet (68); the second end of the conduit (52) being positioned to direct a flow of air from the air supply into the fluid chamber against the fluid thereby generating a vapor/fog; and a second conduit (see Fig. 2 below) for delivering the vapor/fog from the fluid chamber to the system, the second end having a first end received in the outlet and a second end receivable in the system; further comprising a spray nozzle (58, 60) attached to the second end of the first conduit for directing flow of air against the fluid; and an air pressure regulator/valve/controls located in the first conduit for controlling pressure of the air from the first conduit. Since the “system” are/is not part of the claims, they are not given any patentable weight. Furthermore, the “adapted to” phrases such as “adapted to deliver vapor under pressure to a system....” is an intended use and/or desired result which carries no patentable weight. Lastly, functional recitation(s) using the words “for” have been given little patentable weight because they fail to add any structural limitations and thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Finstewalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). **When interpreting functional language, if the prior art is capable of performing the claimed function-even if not directly disclosed-it anticipates. *In re***

Art Unit: 2856

Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Sinex*, 309 F.2d 488, 135 USPQ 302 (CCPA 1962). See also MPEP § 2114, 2115.

7. Claim 20 is rejected under 35 U.S.C. § 102(b) as being anticipated by US 4,836,452 to Fox. Fox discloses a leak detector (Figs. 1-8) for delivering vapor/fog (i.e. fine droplets or mist) for detecting leaks in the system having: a tank/housing (54) defining a vapor/fog producing fluid (14), an air supply (40); the tank further defining a an inlet/first opening (68) (see Fig. 2 above) and an outlet/second opening (30, 36); a first conduit (22) for delivering air from the air supply to the fluid chamber having a first end for attachment to the air supply and a second end received in the inlet (68); the second end of the conduit (52) being positioned to direct a flow of air from the air supply into the fluid chamber against the fluid thereby generating a vapor/fog; and a second conduit (see Fig. 2 below) for delivering the vapor/fog from the fluid chamber to the system, the second end having a first end received in the outlet and a second end receivable in the system. Since the “system” are/is not part of the claims, they are not given any patentable weight. Furthermore, the “adapted to” phrases such as “adapted to deliver vapor under pressure to a system....” is an intended use and/or desired result which carries no patentable weight. Lastly, functional recitation(s) using the words “for” have been given little patentable weight because they fail to add any structural limitations and thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Finstewalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of

Art Unit: 2856

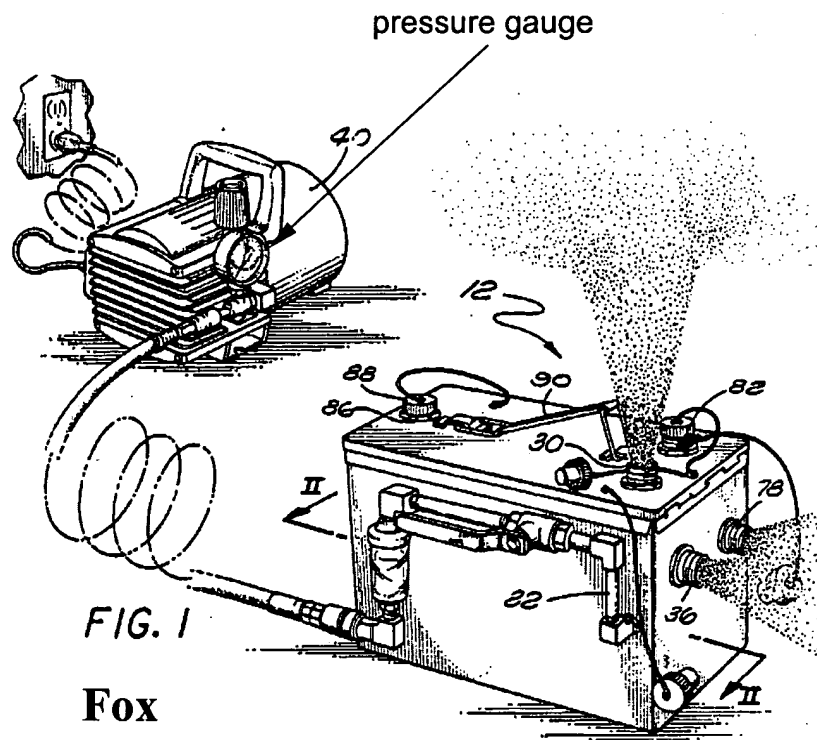
patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA1963). **When interpreting functional language, if the prior art is capable of performing the claimed function-even if not directly disclosed-it anticipates.** *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Sinex*, 309 F.2d 488, 135 USPQ 302 (CCPA 1962). See also MPEP § 2114, 2115.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 18 rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,836,452 to Fox. Fox discloses an apparatus for leak testing having all the elements stated previously. Fox further discloses the employment of an external air gauge in cooperation with the air supply (see Fig. 1 below), however, does not located the pressure gauge within the housing operatively coupled to the second conduit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the pressure gauge, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950)



Allowable Subject Matter

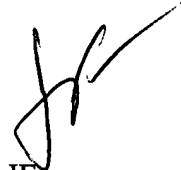
10. Claims 5, 7-10, 14-17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Banyard et al., Scaringe et al., Gilles et al., Hughes and Briggs all disclose various elements of the instant invention, including pressure regulators, switches and valves for controlling fluid/vapor flow in leak detection apparatuses.

Art Unit: 2856

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Fitzgerald whose telephone number is (571) 272-2843. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JF

11/01/2004



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